

**REMARKS**

Claims 1, 4-14, 20, 28-41 and 45 have been rejected as reciting subject matter obvious over the disclosures contained in the Yoshikawa and Tanaka documents.

Claims 16-19, 21-27 and 38 have been rejected as reciting subject matter obvious over the disclosures contained in the Yoshikawa, Tanaka, and Vranish documents.

Claims 42 and 44 have been rejected as reciting subject matter obvious over the disclosures contained in the Yoshikawa, Tanaka, and Lin documents.

Claim 43 has been rejected as reciting subject matter obvious over the disclosures contained in the Yoshikawa, Tanaka, Lin, and Files documents.

The claims at issue include a single independent claim, Claim 1, and all the remaining claims depend directly or indirectly therefrom. Accordingly, if Claim 1 is allowed, all of the claims depending directly or indirectly therefrom must also be allowable.

As set forth above, Claim 1 has been rejected as reciting subject matter obvious over the disclosure contained in the Yoshikawa document and purportedly modifiable by the disclosure contained in the Tanaka document in order to obtain and render obvious the subject matter of Claim 1. For reasons set forth below, the proposed modification of the Yoshikawa device with

the alleged teachings contained in the Tanaka document would result in an inoperative device and would be contrary to the teachings and purpose of the Yoshikawa disclosure. The basis for this inevitable conclusion is set forth below.

### **Independent Claim 1**

Although we do not agree with the interpretation of Yoshikawa et al. detailed in the Office Action of 26 November 2011, particularly the allegation that the electrodes 7 of that document may be understood by one skilled in the art to offer the functionality of the electrically “conductive medium” as defined by Claim 1, we propose amending Claim 1 in order to further distinguish from the prior art.

Claim 1 has been amended to define that the plurality of spaced apart conductors comprise “a first series of conductors extending in a first direction and a second series of conductors extending in a second, different, direction”. Therefore, Claim 1 now defines a first series of conductors, a second series of conductors and an electrically conductive medium as separate integers of the touchpad.

Page 7, lines 26 to 28 of the published PCT application from which this US patent application is derived states that “the first and second series of conductors 2 need not be parallel, nor is it necessary for the first and second series of conductors to be mutually orthogonal”.

When Yoshikawa is considered in light of the amended claims, it will be appreciated that the electrode elements 6 and 7 of Yoshikawa which were previously considered as relevant to the “plurality of spaced apart conductors” and “conductive medium” of former Claim 1, might now be considered by the Examiner as relating to the first and second series of conductors of amended Claim 1. We respectfully submit that there is no structure in Yoshikawa that can be considered as relevant to the “electrically conductive medium” as defined by amended Claim 1.

More specifically, there is no feature in Yoshikawa that could be considered as relevant to the “electrically conductive medium being proximal to said plurality of spaced apart conductors to concentrate an electric field between said spaced apart conductors towards the plane of said supporting medium and adapted to locally modify a capacitive environment between a subset of said plurality of spaced apart conductors without distortion of said conductive medium, wherein said conductive medium has a resistivity in the range of 100 ohms per square to 10,000,000 ohms per square”, as claimed.

The “electrically conductive medium” provides the technical advantage that has been discussed in the previous submissions to the USPTO; that is, it can vary the local capacitive field between the spaced apart conductors so as to improve the performance of the touchpad. There is no such teaching or suggestion of operating the device of Yoshikawa in this manner.

In light of our submission that Yoshikawa does not have any conductive layer that could

be considered as being capable of providing the functionality of the “conductive medium” of amended Claim 1, we submit that it would not be obvious to introduce a new conductive layer from any other prior art document; there is simply no teaching in the prior art that doing so would improve the performance of the touchpad. We respectfully submit that any suggestion that it would be obvious for the skilled person to introduce a “conductive medium” as claimed to the tablet of Yoshikawa is based on hindsight and not the teachings of the prior art.

In response to the statement at the top of Page 16 of the Office Action dated November 26, 2010, we respectfully submit that just because the applicant has found that a certain conductive medium has advantageous properties does not mean that it would have been obvious, at the time the invention was made, for the skilled person to modify known devices (such as the tablet of Yoshikawa) in a way that provides those advantages. We submit that there must be a disclosure in the prior art such that the missing features from the closest prior art document would be considered as an obvious development to the skilled person.

In the present case, where Yoshikawa does not disclose a relevant conductive medium, we submit that one cannot say that just because the skilled worker would like to eliminate redundancy in design, he or she would then utilize all known materials, with all known properties, in all known testing, certifying and re-designing methods, in order to arrive at the applicant’s claimed subject matter. We respectfully submit that this cannot be the proper test. There must be some teaching in the prior art that causes the specific materials, with the specific

properties, of the claims to be considered obvious to the skilled person. We have been unable to identify any such teaching in the prior art that has been cited against the present application, and therefore submit that the amended claims are not obvious over the prior art.

In relation to Tanaka, which relates to resistance film touch panels, we respectfully submit that Tanaka does not disclose a “conductive medium... to concentrate an electric field between said plurality of spaced apart conductors towards the plane of said supporting medium and adapted to locally modify a capacitive environment between a subset of said plurality of spaced apart without distortion of said conductive medium”. We make this submission based at least on the fact that Tanaka does not relate to capacitive touchpads and therefore the transparent conductive films of Tanaka are arranged to be pressed together to detect a data position at the point of contact between the transparent conductive films (paragraph [0316]).

We respectfully submit that when independent Claim 1 is properly construed as a whole, none of the prior art documents disclose a conductive medium including all of the technical limitations defined by amended Claim 1. We submit that it is inappropriate, and does not give a true reflection of the claimed subject matter, to split up the technical definition of the conductive medium that is provided by Claim 1 and suggest that some of those limitations are present in one prior art document and other limitations are present in another document.

In light of the above, we submit that there is no teaching in any of the prior art documents

that would cause the skilled person to consider the claimed subject matter as a whole to be obvious.

**Dependent Claim 4**

We also put forward the following comments in response to the objections to Claim 4. The Office Action suggest that paragraph [0056] and Figure 1 of Yoshikawa teach that the “electrically conductive medium is adapted to accentuate the variation in capacitance of a conductor and to control the dispersion of a resulting capacitive signal propagating from substantially the proximity of the finger”. However, we respectfully submit that paragraphs [0051], [0056] and [0071] of Yoshikawa all teach that the row electrodes 7 and the column electrodes 6 both interact with the stylus, but it does not teach that the row electrodes 7 are used to modify the field of the column electrodes 6 as would be required in order to maintain an interpretation of the prior art that one of the sets of electrodes (6 or 7) of Yoshikawa is relevant to the conductive medium of the present application. Therefore, we submit that Claim 4 is not obvious, at least because one set of the electrodes of Yoshikawa cannot accentuate the variation in capacitance of the other set of electrodes, nor can the electrodes control the dispersion of a resulting capacitive signal propagating from substantially the proximity of the finger.

In view of the amendments to Claim 1 to more particularly point out and distinctly claim the invention, the detailed analysis of the structures, purposes and operation of the Yoshikawa and Tanaka devices, it is submitted that Claim 1 is allowable and that the application is in

condition for allowance, which allowance is respectfully requested.

Respectfully submitted,

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